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09/839,887	04/20/2001	Kevin R. Willett	85939.000193	4285
23387	7590	05/07/2004	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			UHLIR, NIKOLAS J	
		ART UNIT		PAPER NUMBER
				1773

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/839,887	Applicant(s) WILLETT, KEVIN R.
Examiner	Art Unit 1773	
Nikolas J. Uhlir		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 20 April 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20,23-44,46-50,52-56,58-61 and 63-65 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20,23-44,46-50,52-56,58-61 and 63-65 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. This office action is in response to the amendment/request for continued examination (RCE) dated 4/20/2004. The applicant's submissions are sufficient to overcome all of the previous grounds of rejection. Accordingly, these grounds are withdrawn. However, the case is not in condition for allowance in view of the new grounds of rejection set forth below.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 5-8, 10, 13-20, 23-24, 26, 33-39, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al. (US5545448) in view of Rinehart et al. (US5827608).

4. Claim 5 requires an automotive weather seal comprising: a) a substrate having a first portion formed of a first polymeric material and a second and a second portion formed from a different second polymeric material; and b) a colliquefiable powder coating directly adjacent the first portion and directly adjacent the second portion, the colliquefiable powder coating selected to colliquefy into a continuous coating on the first portion and the second portion.

5. Regarding these limitations, Ford teaches an automotive weather seal that comprises a seal portion 1, a trim or carrier portion 3, and a u-shaped metal reinforcing member 7 (see figure 1 and column 2, lines 20-34). The seal portion can be formed from a foamed elastomeric material such as EPDM rubber (a known thermosetting

material), and is equivalent to applicant's claimed first portion made of a first polymeric material (column 2, lines 64-65). The trim or carrier portion 3 can be formed from a colored plastics material, and is equivalent to applicants claimed second portion of second polymeric material (column 2, lines 28-32). Colored plastic and foamed EPDM are different polymeric materials. Thus, the limitation in claim 5 requiring different polymeric materials is met. Further, Ford teaches that the entire (seal and trim) of the weather seal can be coated with a solvent based colored coating so as to match the color of the weather seal to the paintwork of the automobile (column 2, lines 30-35, column 3, lines 15-20).

6. Ford fails to teach a colliquefiable powder coating selected to colliquefy into a continuous coating on the first portion and the second portion, as required by claim 5.

7. However, with respect to this deficiency, Rinehart teaches in the background that solvent based spray coatings to coat extruded articles are disadvantageous because of the negative environmental impact of the solvent (column 1, lines 22-29). Powder coating is solvent free, and is recognized by the prior art to be equivalent to solvent based coating as a method for forming a continuous coating on an extruded article (column 1, lines 45-63). In powder coating, a powder is applied to a substrate and then subsequently heated. During the heating step, individual powder particles melt and flow into one another, forming a continuous coating (column 1, lines 45-63). As a result of its solvent free nature, powder coating does not exert the same deleterious environmental effects on the environment as solvent based coating (column 1, lines 45-63).

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8. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the powder coating method taught by Rinehart to form the colored polymer layer taught by Ford.

9. One would have been motivated to make this modification in view of the fact that powder coating and solvent based spray coatings are recognized in the art to be equivalent methods for forming a continuous coating on an extruded article. Further, the solvent free nature of powder coating would motivate one of ordinary skill in the art to select this method because powder coating avoids the environmental impact of solvent based spray coating.

10. It is the examiners position that when powder coating is utilized to form the colored layer of Ford, the limitations of claim 5 are met. Given that Ford desires a continuous coating (and powder coating can achieve this type of coating), at some point during the powder coating process, a colliquefiable powder coating selected to colliquefy into a continuous coating will be present on the entire surface of the weather seal.

11. Claim 6 requires the second polymeric material to be a thermoplastic material. As set forth above for claim 5, Ford teaches that the static trim portion is made of a plastic material. "Plastic" materials include thermoplastic and thermosetting materials. Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to select a thermoplastic or thermoset material for the trim portion of Ford due to the fact that Ford teaches that all plastic materials are equivalent for forming the trim portion.

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12. Claim 7 requires a metallic reinforcing member connected to one of the first portion and second portion. The metal reinforcing member of Ford is equivalent to applicant's claimed metal reinforcing member. Thus, this limitation is met as set forth above for claim 5.

13. Claim 8 requires a colliquefaction of the powder coating to have a thickness between 0.05-2mm. The amount of powder present on the surface of a substrate during a powder coating process impacts the thickness of the powder coating, with greater amounts of powder resulting in thicker coatings. Thus, the amount of powder on the surface of the weather seal taught by Ford as modified by Rinehart is a results effective variable.

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to control the amount of powder present on the surface of the weather seal so as to obtain a coating with a desired thickness.

15. Claims 10, 13 and 15 require essentially the same limitations as claims 5 and 7-8 with the only difference in claim 10 from claim 5 being the substitution of the phrase "a weather seal body" for the phrase "a substrate" in step "a" of claim 10. Thus, these limitations are met as set forth above for claim 5 and 7-8.

16. Claim 14 requires the first portion to be a thermosetting material and the second portion to be a thermoplastic material. These limitations are met as set forth above for claim 6.

17. Claim 16 requires a u-shaped reinforcing member. This limitation is met as set forth above for claim 5.

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18. Claim 17 is met as set forth above for claim 10.
19. Claim 18 is met as set forth above for claim 5 because the powder coating utilized by Ford as modified by Rinehart is present over the entire surface of the weather seal, including the seal portion.
20. Claim 19 requires the powder coating to be selected to form a colliquefaction having a gloss appearance. The requirement that the colliquefaction have "a" gloss is read on by any coating, because any coating has some level of gloss, even if the coating is only marginally glossy. Thus, this limitation is met as set forth above for claim 5.
5. The limitations of claim 20 are met as set forth above for claim 5. The powder coating utilized by Ford as modified by Rinehart is equivalent to applicant's claimed heat fusible powder coating. Furthermore, the powder coating of the Ford/Rinehart combination is directly on the surface of the entire weather seal, including the seal and trim portions (equivalent to applicants claimed resilient seal and base portions respectively).
21. Claims 23-24 require the base to include a metal reinforcing member and a trim portion, wherein the heat fusible powder is located on the trim portion. These limitations are met as set forth above for claim 20.
22. Claim 26 requires the base to comprise a trim that is of a different material than the seal portion, wherein the powder coating is on the trim portion. These limitations are met as set forth above for claim 5.
23. Claim 33 requires the trim portion to be formed from a thermoplastic material. This limitation is met as set forth above for claims 26 and 6.

24. Claim 34 requires the trim portion to be a thermoset material. As set forth above for claim 6, the trim portion of Ford is formed from a plastic material. Plastics are known to include thermosetting and thermoplastic materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a thermosetting material to form the trim portion of Ford, as all plastic materials are taught to be equivalent for forming the trim.

25. Claim 35 requires essentially the same limitations as claim 5, with the only difference being the requirement of a "heat fusible" powder coating as opposed to a "colliquefiable" powder coating. These limitations are met as set forth above for claim 5.

26. Claim 36 requires one of the first and second portions to form a trim portion of the weather seal. This limitation is met as set forth above for claim 5.

27. Claims 37-39 are met as set forth above for claim 5. The metal reinforcing member of Ford meets all of these limitations.

28. Claim 42 requires essentially the same limitations as claim 35, except that claim 42 requires a weather seal body, as opposed to a substrate. This limitation is met as set forth above for claim 35.

29. Claim 43 requires a trim portion, this limitation is met as set forth above for claim 42.

30. Claims 1-4, 40-41, 44, 46-50, and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh (US5291076) in view of Ford, Rinehart, and Junker (US4994311).

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31. Claim 1 requires an automotive weather seal, comprising: a) a resilient polymeric body; b) a metal reinforcing member connected to the body; and c) a heat fusible powder coating directly on a portion of the metal reinforcing member and directly on a portion of the resilient polymeric body, the heat fusible powder coating being selected to fuse a contiguous surface film on the portion of the metal reinforcing member and the portion of the resilient polymeric body.

32. Regarding these limitations, Katoh teaches an automotive weather seal comprising a metal sheet 2, a body 1, and layers 3a3, 3b3, lips 3c3 (figure 4b and column 3, lines 50-65). The metal layer 2 is considered by the examiner to be equivalent to applicants claimed metal reinforcing layer. As can be seen from figure 4b, at least a portion of the metal layer 2 is exposed. The body 1, layers 3a3, 3b3, and lips 3c3 are made of polymer materials, and are considered by the examiner to be equivalent to applicants claimed resilient polymeric body (column 2, line 63-column 3, line 12). It is noted that the weather seal of Katoh is formed by extrusion (column 3, lines 13-18)

33. However, Katoh fails to teach a heat fusible powder coating directly on the surface of the metal reinforcing member and directly on a portion of the resilient polymeric body, wherein the heat fusible powder coating is selected to fuse as a contiguous surface film on the portion of the metal reinforcing member and the resilient polymeric body, as required by claim 1.

34. However, Ford teaches that the entire (seal and trim) of an automotive weather seal is advantageously coated with a colored coating so as to match the color of the

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weather seal to the paintwork of the vehicle (Ford column 2, lines 30-35, column 3, lines 15-20). Bearing this in mind, Rinehart teaches that solvent free powder coating is recognized in the art to be a suitable method for forming a continuous coating on an extruded article (Rinehart column 1, lines 45-63). Further, as shown by Junker, powder coating an automotive weather seal with a colored powder to match the paintwork of the vehicle is known (Junker column 2, lines 5-45). As shown by Rinehart, during powder coating, a powder is applied to a substrate and then subsequently heated. During the heating step, individual powder particles melt and flow into one another, forming a continuous coating (Rinehart column 1, lines 45-63). Rinehart and Junker specifically teach that powder coatings can be applied to a variety of substrates, including those made from thermoplastic, thermoset, metal, and foamed polymers (Rinehart column 6, lines 8-34; Junker column 2, lines 55-69).

35. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the entire weather seal of Katoh (including the exposed metal portion) with a continuous colored coating per the teachings of Ford, with a powder coating, per the teachings in Rinehart and Junker.

36. One would have been motivated to coat the entire surface of the Katoh weather seal with a colored coating in view of the teaching in Ford that the entire surface of an automotive weather seal is adventitiously coated with a colored coating so as to match the paintwork of the vehicle. One would have been motivated to use a colored powder coating to achieve this in view of the fact that the Katoh weather seal is formed by extrusion and in view of the teachings in Rinehart and Junker that colored powder

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coatings are known in the art to be suitable for forming colored layer over the surface of an extruded article. Finally, as shown by Junker and Rinehart, a colored powder coating is capable of adhering to all of the surfaces of the weather seal of Katoh.

37. The claim 1 limitation requiring the powder coating to be selected to fuse as a contiguous film on the surface of the metal reinforcing member and the resilient polymeric body is met by the above combination. At some point during the powder coating of the Katoh weather seal, the amount of powder utilized will be sufficient to form a contiguous coating over the surface of the weather seal.

38. Regarding the above combination. The examiner notes that Ford teaches the use of a solvent-based solution to coat the surface of a weather seal. This fact does not detract from the overall motivation to coat the entire surface of a weather seal with a colored coating to match the paintwork of the vehicle. Further, one would have been motivated to use a powder coating instead of a solvent based coating in view of the teaching in Rinehart that powder coatings do not exhibit the a deleterious effect on the environment as a solvent based coating because powder coating is solvent free.

39. Claim 2 requires the weather seal of claim 1 to comprise a trim portion and a sealing portion. It is the examiners position that the exposed portion of the metal 2 is equivalent to the applicant's claimed trim portion and the 3b3 and lips 3c3 of Katoh to be equivalent to the applicant's claimed sealing portion.

40. Claim 3 requires the amount of powder be selected to form a coating having a thickness <0.2mm. The amount of powder present on the surface of a substrate during a powder coating process impacts the thickness of the powder coating, with greater

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amounts of powder resulting in thicker coatings. Thus, the amount of powder on the surface of the weather seal taught by Katoh as modified by Ford, Rinehart, and Junker is a results effective variable.

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to control the amount of powder present on the surface of the weather seal so as to obtain a coating with a desired thickness.

42. Claim 4 requires the metal reinforcing member to be partially covered by the polymeric body. As seen by figure 4b of Katoh, metal 2 is partially covered by body 1. Thus, this limitation is met.

43. Claim 40 is met as set forth above for claim 1. The metal layer of Katoh is equivalent to applicants claimed reinforcing member. Further, figure 4c clearly shows that polymeric body 2 of Katoh engages the automotive vehicle.

44. Claim 41 requires the polymeric body to include a trim portion, this limitation is met as set forth above for claim 2.

45. Claim 44 requires a vehicle weather seal comprising a thermoplastic weather seal body having a sealing portion and a carrier portion, and a heat fusible powder coating directly on at least a portion of a surface of a sealing portion and the carrier portion, wherein the powder coating is fusible into a contiguous layer on the surface of the sealing portion and the carrier portion.

46. Regarding the requirement of a thermoplastic weather seal body, Katoh teaches that the polymeric body 2 is suitably made from acrylonitrile-butadiene-styrene,

polycarbonate, polyphenylene oxide, acrylonitrile-styrene, polypropylene, polyvinyl chloride, polyamide or other materials.

47. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize polypropylene to form the body 2 of Katoh, as Katoh teaches the equivalence of polypropylene to the other materials listed as suitable for this purpose.

48. It is noted that polypropylene is a known thermoplastic material. The remainder of the limitations of claim 44 are met as set forth above for claim 1.

49. Claim 46 requires the weather seal of claim 44 to additionally comprise a trim portion, wherein one of the trim and sealing portions has a foamed, cellular, and sponge structure. The examiner interprets the exposed portion of the metal layer 2 of Katoh to be equivalent to applicant's claimed trim portion. The lips 3c3 of Katoh are considered by the examiner to constitute the claimed sealing portion. Katoh specifically teaches that the protective layers (which include lips 3c3) are suitably made from elastomers such as polyvinyl chloride, thermoplastic polyurethane, foamed rubber, and other materials (column 3, lines 4-12).

50. Therefore it would have been obvious to one of ordinary skill in the art to utilize foam rubber to form the lips 3c3 taught by Katoh, as Katoh recognizes the equivalence of foam rubber to the other materials listed as suitable for forming the lips.

51. The applicant is respectfully reminded that substitution of equivalents requires no express motivation so long as the prior art recognizes the equivalency.

52. Claims 47-48 require a metal reinforcing member in the thermoplastic weather seal body. This limitation is met as set forth above for claim 44.

53. Claim 49 requires the heat fusible powder coating to comprise one of a thermoplastic and a thermoset material. As set forth above for claim 1, Junker teaches that the use of a colored powder coating to coat the surface of a weather seal is known. Junker specifically teaches that suitable powder can comprise powdery thermoplasts (thermoplastics), and crosslinked powdery elastomers (considered to be thermoset).

54. Therefore it would have been obvious to utilize a thermoset or thermoplastic powder to coat the entire surface of the weather seal of Katoh.

55. One would have been motivated to make this modification in view of the teaching in Junker that thermosetting or thermoplastic powders are suitable for coating the surface of a weather seal.

56. The examiner acknowledges that Junker teaches the formation of "islands" of polymer via the powder coating method (for the purpose of improving the frictional characteristics of the coating). It is the examiners position that this simply results from Junker limiting the amount of powder utilized to form the coating so as to prevent individual powder particles from fusing into one another. However, as shown by Rinehart, the formation of a continuous coating by powder coating is known. Further, the desirability of a continuous colored coating is suggested in Ford. Thus, although Junker teaches the benefits of forming "islands" of polymer by the powder coating method, one of ordinary skill, looking at the prior art at a whole, would not have been dissuaded from forming a continuous coating via powder coating.

57. Claims 50 and 52-55 are met as set forth above for claim 44 and 46-49.
58. Claims 9, 11-12, 56, 58-61, and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford as modified by Rinehart as applied to claims 5-8, 10, 13-20, 23-24, 26, 33-39, and 42 above, and further in view Junker.
59. Claim 9 requires the powder coating to be a thermoset material and the second polymeric material to be a thermoplastic material. The requirement that the second material be a thermoplastic material is met as set forth above for claim 6.
60. However, Ford as modified by Rinehart does not teach that the powder coating is thermosetting, as required by claim 9.
61. However, Junker teaches that the use of a colored powder coating to coat the surface of an extruded weather seal is known (column 2, lines 12-45). Junker specifically teaches that suitable powder can comprise powdery thermoplasts (thermoplastics), and crosslinked powdery elastomers (considered to be thermoset) (column 45-55).
62. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a thermosetting powder as taught by Junker to form the powder coating utilized by Ford as modified by Rinehart.
63. One would have been motivated to make this modification in view of the fact that Junker recognizes that thermoset powders and thermoplastic powders are equivalent for use as forming a powder coating on an extruded weather seal.
64. The examiner acknowledges that Junker teaches the formation of "islands" of polymer via the powder coating method (for the purpose of improving the frictional

characteristics of the coating). It is the examiners position that this simply results from Junker limiting the amount of powder utilized to form the coating so as to prevent individual powder particles from fusing into one another. However, as shown by Rinehart, the formation of a continuous coating by powder coating is known. Further, the desirability of a continuous colored coating is suggested in Ford. Thus, although Junker teaches the benefits of forming "islands" of polymer by the powder coating method, one of ordinary skill, looking at the prior art at a whole, would not have been dissuaded from forming a continuous coating via powder coating.

65. Claim 11 is met as set forth above for claim 9.

66. Regarding claim 12, wherein the applicant requires the powder coating to be a thermoplastic and the first portion of the weather seal to be a thermoset. The obviousness of using a thermoplastic second portion is set forth above for claim 6. As set forth above at section 61, Junker teaches the equivalence of thermoplastic and thermosetting materials for forming powder coatings on extruded weather seals.

67. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a thermoplastic powder to form the powder coating utilized by Ford as modified by Rinehart.

68. One would have been motivated to make this modification in view of the fact that Junker recognizes that thermoset powders and thermoplastic powders are equivalent for use as forming a powder coating on an extruded weather seal.

69. Claim 56 is met as set forth above for claims 9 and 33.

70. Claim 58 requires the trim or seal portion of the weather seal of claim 56 to have a foamed, cellular, or sponge structure. Ford teaches that the seal can be formed of a foamed elastomeric material (column 2, lines 64-65).

71. Claims 59-60 is met as set forth above for claims 56 and 5.

72. Claims 61 and 63-65 are met as set forth above for claims 56, and 58-60.

***Response to Arguments***

73. The applicants arguments filed 4/20/2004 have been considered but are not persuasive.

74. First, the applicant's arguments with respect to the Junker reference are moot in view of the new grounds of rejection.

75. Second, the applicant's arguments with respect to the teachings of Ford are not persuasive. Specifically, applicant argues that Ford suggests that the application of a continuous coating can only be achieved by a specific spray chemistry, and that the reference expressly discourages the use of extruded colored plastic coatings.

76. Regarding the specific chemistry argument. The examiner agrees with the applicant that Ford does in fact teach that their specific coating chemistry is able to achieve a level of adhesion to the weather seal that is not obtainable with traditional extruded plastic coatings. However, this argument is not persuasive in view of the new grounds of rejection, which utilizes a powder coating to coat the surface of the extruded weather seal of either Ford or Katoh. Further, there is strong motivation to substitute a powder coating for the solvent based spray coating of Ford, namely the fact that a powder coating does not utilize environmentally harmful solvents.

77. Regarding the colored plastics arguments. The examiner respectfully disagrees with the applicant's assertion that Ford teaches away from using colored plastics in general. Rather, Ford teaches away from the use of colored polyvinyl chloride, which is a material that is known to emit toxic vapors when it is burned. Ford cannot possibly teach away from all colored plastic coatings when in fact the spray coating solution used by Ford forms a pigmented polyurethane coating (see column 3, lines 15-45).

78. Third, the applicant has argued that Ford discourages painting of the weather seal because it is not cost effective. The examiner agrees that Ford does in fact teach that painting the weather seal is not economical. However, other prior art, namely Rinehart, clearly shows that solvent based spray coatings are harmful to the environment, wherein a spray coating (while more costly) utilizes no solvent and thus does not harm the environment. The tug of war between environmentally conscious, yet costly processes versus economically desirable, yet environmentally harmful processes is old and well known. Thus, one of ordinary skill in the art would not be dissuaded from utilizing a powder coating instead of a spray coating, as the environmental friendliness of the process would offset the additional costs required.

79. Last, the applicant has argued that modifying the Kato reference so as to coat the metal layer goes against the teachings of the reference. The applicant asserts that reference must teach the asserted combination to sustain the rejection, and that even if the reference is silent, the rejection cannot be sustained.

80. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there

is some teaching, suggestion, or motivation to do so found *either* in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art, looking at the prior art as a whole, would clearly see from Ford that there is a strong motivation to coat the *entire* portion of an automotive weather seal with a colored coating. Specifically, this motivation is to match the color of the weather seal to the paintwork of the vehicle.

81. Further, the examiner respectfully disagrees with the applicant's assertion that covering the metal foil of Katoh would render the foil useless. As is clearly evinced by other relevant prior art, the use of metal reinforcing members embedded in the polymeric body of a weather seal is very well known. Though, the metal surface would be obscured by the colored coating, the foil would serve as a reinforcing member. There is nothing in Katoh that states that the exposed surface of the metal foil is the goal of the reference. Thus, this argument is unpersuasive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on 571-272-1516. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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